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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/839,433	04/20/2001	Claude Jarkae Jensen	10209.56	1737
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KIRTON AND MCCONKIE 60 EAST SOUTH TEMPLE, SUITE 1800 SALT LAKE CITY, UT 84111				
EXAMINER				
YU, GINA C				
ART UNIT		PAPER NUMBER		
1611				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

09/839,433

**Applicant(s)**

JENSEN ET AL.

**Examiner**

GINA C. YU

**Art Unit**

1611

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12 April 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1, 7, 8, 11, 12, 22 and 27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 7, 8, 11, 12, 22 and 27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SE/C2)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on April 12, 2010 has been entered.

Claim rejection made under 35 U.S.C. 103(a) as being unpatentable over Vatter (US 6224888 B1) in view of Wadsworth (WO 01/15537 A1) and Ferrari et al. (US 6402408 B1) as indicated in the previous Office action dated January 12, 2010 is maintained for reasons of record.

### ***Priority***

The later-filed application must be an application for a patent for an invention which is also disclosed in the prior application (the parent or original nonprovisional application or provisional application). The disclosure of the invention in the parent application and in the later-filed application must be sufficient to comply with the requirements of the first paragraph of 35 U.S.C. 112. See *Transco Products, Inc. v. Performance Contracting, Inc.*, 38 F.3d 551, 32 USPQ2d 1077 (Fed. Cir. 1994).

The disclosure of the prior-filed application, Application No. 60/251,416 filed on December, 5, 2000, fails to provide adequate support or enablement in

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the manner provided by the first paragraph of 35 U.S.C. 112 for one or more claims of this application.

The provisional application only discloses experimental results of enzyme essays to test COX-1 and COX-2 inhibition effect of "TNJ", which is viewed Tahitian noni juice (*Morinda citrifolia* juice). There is no support for *Morinda citrifolia* "seed oil" which is the essential active ingredient of the present invention. Furthermore, no description for the topical formulation and ingredients used in the present invention is provided in the provisional application. Therefore the disclosure of application no. 60/251416 does not convey to a skilled artisan that applicant was in possession of the presently claimed invention at the time of the filing of the provisional application.

Accordingly claims 1, 7, 8, 11, 12, 22, and 27 are not entitled to the benefit of the prior-filed application.

***Claim Rejections - 35 USC § 103 (Maintained)***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

**Claims 1, 7, 8, 11, 12, 22 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vatter (US 6224888 B1) in view of Wadsworth (WO 01/15537 A1) and Ferrari et al. (US 6402408 B1).**

Vatter teaches lipstick composition comprising candelilla wax, ozokerite wax, pigments in castor oil. The lipstick formulation of Example I further contains 4.1 % of beeswax (claim 7), 7 % of lanolin (claim 8). Using sorbitan esters as an emollient emulsifier is taught in col. 5, lines 43 – 60. Further adding suitable

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emollient oils that impart viscosity, "tackiness and drag properties" is also suggested in col. 6, lines 18 – 33. The suitable oils include shea butter, jojoba oil, lanolin, isopropyl palmitate, isopropyl myristate, tocopheryl acetate, tocopheryl linoleate, and plant-based triglycerides, etc. See instant claims 1 and 27. Vatter further teaches using up to about 90 %, more preferably from 1-50%, even more preferably from about 5-40 % of solidifying agents to solidify a liquid base materials to be used in a cosmetic composition See col. 8, lines 11 – 30. Paraffin wax is mentioned in col. 8, line 40. See instant claim 22. Using paraffin wax, which is another name for white petrolatum, to solidify the cosmetic composition as taught by the reference would have been obvious.

While Vatter teaches using essential oils from plants as emollient oils, the reference fails to teach *Morinda citrifolia* seed oil and macadamia oil.

Wadsworth teaches using *Morinda citrifolia* seed oil as an antioxidant for various applications including making cosmetics. See p. 4, lines 21 – 25.

Vatter and Wadsworth do not specifically teach the amount of the essential oil to use in a cosmetic.

Ferrari teaches that it is a well-known practice in cosmetic art to use additives such as antioxidants or essential oils, particularly for lipstick formulations, in the concentration of up to 20 or 10 % by weight of the total weight of the composition. See col. 7, lines 11 - 22. The reference also teaches macadamia oil contains a high content of triglyceride suitable for cosmetic formulations. See col. 6, line 48.

It would have been obvious to one of ordinary skill in the art at the time of the present invention to modify the teachings of Vatter by further incorporating *Morinda citrifolia* seed oil as motivated by Wadsworth because Vatter teaches incorporating essential oils from plants and Wadsworth teaches using *Morinda citrifolia* seed oil as an antioxidant for cosmetics. Since Ferrari teaches essential oils or antioxidants are conventionally used in an amount up to 20 or 10 % by weight, the skilled artisan would have had a reasonable expectation of successfully producing a stable lipstick composition with improved antioxidant property. Further incorporating macadamia oil to the cosmetic of Vatter would have been also obvious in view of Ferrari because both of the references teach using plant-based hydrocarbon oils to make cosmetic products.

### ***Response to Arguments***

Applicant's arguments filed on April 12, 2010 have been fully considered but they are not persuasive.

Applicant asserts that the present application claims the benefit of the filing date of provisional application 60/251,416, filed on December 5, 2000. Applicant also asserts that Wadsworth (WO 01/15337) should not be used as a prior art against the present claims allegedly because it is a prior art under 102(e) which was subject to an obligation of assignment to the same person.

First, the presently claimed subject matter is not afforded the benefit of the filing date of the provisional application, as the provisional application fails to meet the written description requirement under 35 U.S.C. § 112, first paragraph as discussed above. Therefore, the effective filing date for the present invention

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is the filing date of the present invention, which is **April 20, 2001**. Wadsworth, which was published **March 8, 2001**, is therefore an 102(a) reference under 35 U.S.C. The 102(e) statute only applies to U.S. patents or U.S. patent applications, thus Wadsworth is not a 102 (e) reference.

Therefore, Wadsworth is still considered as a valid prior art applicable under 35 U.S.C. § 103 (a); the obviousness rejection of previous final Office action dated January 12, 2010 is thus maintained for reasons of record.

### ***Conclusion***

No claim is allowed.

This is a continued examination under 37 CFR 1.114. All claims are drawn to the same invention claimed in the previous prosecution and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier prosecution. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will

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the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to GINA C. YU whose telephone number is (571)272-8605. The examiner can normally be reached on Monday through Thursday, from 8:00AM until 6:00 PM..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sharmila Landau can be reached on 571-272-0614. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/GINA C. YU/  
Primary Examiner, Art Unit 1611



